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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,321	10/03/2003	Herbert Andre Jansen	05015228-92US1 PTN/df	9461

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EXAMINER	
BOLES, SAMEH RAAFAT	

ART UNIT	PAPER NUMBER
3775	

MAIL DATE	DELIVERY MODE
03/28/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/677,321	JANSEN ET AL.	
	Examiner	Art Unit	
	SAMEH BOLES	3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2012*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1-3 and 5-8* is/are pending in the application.

5a) Of the above claim(s) *1 and 2* is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *3 and 5-8* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☒ The drawing(s) filed on *7/13/04* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

According to the Amendment filed on January 10, 2012, claims 1-2 are withdrawn, claims 3 and 7 are amended, claim 4 is cancelled and claims 3, and 5-8 are examined in this office action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 3, 5-6, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US. Pat. No. 5171248) in view of Brosseau et al. (US. Pat. No. 6450978 B1).

Ellis discloses an apparatus (Fig. 3) capable of obtaining an axis of an intramedullary canal of an exposed bone comprising: a stem portion (12) having a leading end insertable in an intramedullary canal of the bone through an opening in the bone, and being adapted to be handled by a following end thereof (see modified figure 3 below); and a tip portion (see modified figure 3 below) at the leading end of the stem portion, the tip portion having two fingers (32 and 34, Fig. 5) actuatable (see Figs. 1-3) from the following end of the stem portion to extend radially (Fig. 3) from the stem portion (12) with tips (72) of the fingers (32 and 34) being equidistantly spaced (Fig. 3) from the stem portion and capable to center the leading end of the stem portion in the intramedullary canal by contacting the surface of the intramedullary canal, wherein the

fingers are pivotally mounted to one another (col. 3, lines 19-23), wherein the fingers are biased to be retracted radially (Fig. 1), so as to facilitate an insertion of the stem portion in the intramedullary canal. The stem portion is graduated (78) on an outer surface thereof to indicate a depth of insertion of the stem portion in the intramedullary canal (Fig. 3).

Ellis fails to disclose a position tracking system and a computer-assisted surgery system comprising a detectable device trackable in space; the tracking system for tracking the detectable device; and the computer-assisted surgery system for determining at least an orientation of the apparatus, the computer-assisted surgery system comprising a user interface for outputting data.

Brosseau teach a surgical tool (20, Figs. 1 and 2) with a combination with a position tracking system (22, Fig. 1) and a computer-assisted surgery system (10, Figs. 1 and 3) comprising a detectable device trackable (42, Fig. 2) secured to the surgical device (20) in space, wherein the tracking system (22) for tracking the detectable device (42) (col. 5, lines 24-27); and the computer-assisted surgery system (10) for determining at least an orientation of the apparatus (abstract), the computer-assisted surgery system comprising a user interface such as a display monitor (18, Figs. 1 and 3) capable of outputting data.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the apparatus of Ellis with a combination with a position tracking system and a computer-assisted surgery system comprising a detectable device trackable in space and a user interface for outputting data in view of

Brosseau for effectively and accurately tracking the position of the apparatus with respect to the anatomy bone.

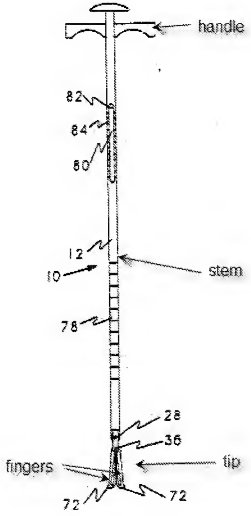

FIG. 3

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Brosseau and further in view of Kuslich et al. (US. pat. No. 6620162).

Ellis in view of Brosseau fails to teach a flared adapter slidingly mounted on the stem portion, the flared adapter being flared toward the following end of the stem portion to engage with a surface of the intramedullary canal at the opening of the intramedullary canal, to center the stem portion in the intramedullary canal.

Kuslich teaches a flared adapter (100, fig. 5) slidingly mounted on the stem portion (14), the flared adapter being flared toward the following end of the stem portion to engage with a surface of an opening of the operation site (96) (Fig. 5), and capable to center the stem portion in the opening and to control the insertion depth of the stem (col. 7, lines 62-67).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the combination device of Ellis in view of Brosseau with a flared adapter further in view of Kuslich for effectively controlling the insertion depth of the stem.

Response to Arguments

Applicant's arguments with respect to claims have been fully considered but they are not persuasive.

Applicant argues that Brosseau fails to teach a computer- assisted surgery system for digitizing the intramedullary canal of the bone from the orientation of the apparatus when the fingers are actuated into contacting the surface of the intramedullary canal, and fails to teach a user interface for outputting data related to the axis of the intramedullary canal from the tracking of the detectable device and from the digitization of the intramedullary canal.

Examiner respectfully disagrees since it is noted that "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Also, since a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). In this case, the computer- assisted surgery system taught by Brosseau is capable of digitizing the intramedullary canal of the bone from the orientation of the apparatus when the fingers are actuated into contacting the surface of the intramedullary canal, and the user interface taught by Brosseau is capable of outputting data related to the axis of the intramedullary canal from the tracking of the detectable device and from the digitization of the intramedullary canal.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh R Boles whose telephone number is (571)270-5537. The examiner can normally be reached on WORK SCHEDULE.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Thomas Barrett, at 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMEH BOLES/

Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775